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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,300	06/18/2003	Mark J. Clifford	RUBI5850	5880
22430	7590	03/24/2005	EXAMINER	
YOUNG LAW FIRM A PROFESSIONAL CORPORATION 4370 ALPINE ROAD SUITE 106 PORTOLA VALLEY, CA 94028				FOREMAN, JONATHAN M
		ART UNIT		PAPER NUMBER
		3736		

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/601,300	CLIFFORD ET AL.	
	Examiner Jonathan ML Foreman	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 March 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-49 is/are pending in the application.  
 4a) Of the above claim(s) 32-49 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-31 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 5/7/04;10/13/04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Election/Restrictions*

1. Claims 32 – 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/05.

### *Information Disclosure Statement*

The information disclosure statements filed 5/7/04 and 10/13/04 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. The information disclosure statements have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### *Specification*

2. The disclosure is objected to because of the following informalities: Page 20 line 20 refers to reference numeral 118 being shown in Figure 1B. However, no such reference numeral is in Figure 1B. Page 26, line 17 states “US 09/xxx,xxx filed xx/xx/xx”. Page 35, line 23 states “Fig. 154”.

Appropriate correction is required.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Page 20 line 20 refers to reference numeral 118 being shown in Figure 1B. However, no such reference numeral is in Figure 1B. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only

one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,508,773 to Burbank et al.

In regards to claims 1 – 31, Burbank et al. discloses a device for collecting a tissue specimen including a shaft defining a proximal end (24) and a distal end (26); a specimen collection assembly disposed near the distal end, the specimen collection assembly including a flexible membrane (14) configured to collect the specimen (Col. 10, lines 60 – 62); a specimen management assembly (32, 56), the specimen management assembly being coupled to the specimen collection assembly and configured to draw the specimen collected in the flexible membrane toward the shaft (Col. 13, lines 13 – 40). The flexible membrane is configured to isolate the collected specimen from a mass of tissue surrounding the specimen. The specimen management assembly is coupled to the flexible membrane . The specimen management assembly is configured to selectively pull on the flexible

membrane in at least one direction that is parallel to the shaft (Col. 13, lines 13 – 40). The specimen management assembly is configured to selectively pull on the flexible membrane both toward the distal (Col. 13, lines 25 – 27) and proximal (Col. 13, lines 38 – 41) ends of the shaft. The specimen management assembly is configured to selectively pull on the flexible membrane only toward the distal end of the shaft (Col. 13, lines 25 – 27). The specimen management assembly is configured to selectively pull on the flexible membrane only toward the proximal end of the shaft (Col. 13, lines 38 – 41). A portion of the flexible membrane is attached to the distal end of the shaft. The specimen management assembly includes at least one wire (48, 56) coupled to the flexible membrane. The at least one wire is configured to selectively pull on the flexible membrane in at least one direction that is parallel to the shaft (Col. 13, lines 13 – 40). The at least one wire is configured to selectively pull on the flexible membrane both toward the distal end of the shaft and toward the proximal end of the shaft (Col. 13, lines 13 – 40). The at least one wire is configured to selectively pull on the flexible membrane only toward the distal end of the shaft (Col. 13, lines 25 – 27). A portion of the flexible membrane is secured to the distal end of the shaft. The device includes a specimen cutting assembly (88) configured to cut the specimen from a mass of tissue.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application No. 2003/0229343 to Albrecht et al. and U.S. Patent No. 6,780,179 to Lee et al. disclose devices for collecting a tissue sample having specimen collection assemblies including flexible membranes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMLF

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ART EXAMINER  
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